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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,185	04/09/2004	Richard Eric Lander	MSFT-2950/307196.01	1793

41505 7590 10/04/2006

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EXAMINER
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HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/822,185	<b>Applicant(s)</b> LANDER, RICHARD ERIC	
	<b>Examiner</b> Nathan Hillery	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/9/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner. *NH*  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/9/04</u> <i>NH</i> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Application filed on 4/9/04.
2. Claims 1 – 30 are pending in the case. Claims 1, 13 and 23 are independent.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 – 30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 1 – 12 and 23 – 30 recite nonfunctional descriptive material per se. Non-functional descriptive material per se is an abstract idea, and therefore is not statutory. Non-functional descriptive material is not statutory even if in combination with a physical medium. No useful, concrete or tangible result is produced since there is no functionality. Although not an exhaustive list, examples of non-functional descriptive material are music, literature, art, photographs, data formats, frames or packets absent claimed structure that imparts functionality, mere arrangements of facts or compilations of data. In this case schemas, even on a computer readable media, are merely compilations of data.

6. Claims 13 – 22 have no practical application of a judicial exception as claimed because there is neither a physical transformation nor a production of a concrete, useful and tangible result.

- a. The claimed invention remains in the abstract and nothing is made available to the user; thus it does not produce a tangible result.
- b. The claims appear to be in the preliminary stages and fall short of the disclosed practical utility. In other words, the claims fail to fulfill and/or reflect the specific, substantial, and credible utility sought by the disclosed invention, and thus do not produce a useful result.

Consequently, claims 13 – 22 are nonstatutory. The claims simply recite declaring and generating data without producing a concrete, useful, and tangible result.

7. Further, to expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 above are further rejected as set forth below in anticipation of applicant amending these claims to make them statutory.

It should also be noted that according to the Interim Guidelines, the examiner should inquire whether there should be a rejection under 35 U.S.C. § 102 or 103. The examiner should determine whether the claimed nonfunctional descriptive material be given patentable weight (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, p 51, last paragraph).

In the instant case, the Office does not give patentable weight to claims 1 – 12 and 23 – 30 because the recited subject matter is merely an arrangement of data that performs no function and effectuates no change in data. For purposes of examination, the Office will interpret claims 1 – 12 and 23 – 30 to be equivalent to claims 13 – 22.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1 – 30 are rejected under 35 U.S.C. 102(a) as being anticipated by Vlist (XML Schema).

10. Regarding independent claim 13, Vlist teaches that a separate schema can be made for simple type definitions (p1, last paragraph), which meet the limitation of **declaring a first group of properties in at least one first schema**, since simple-types.xsd is equivalent to the claimed first schema.

Vlist teaches that a separate schema can be made for complex type definitions (p 2, second block paragraph), which meet the limitation of **declaring at least one intermediate group of properties in at least one second schema, wherein each of said at least one intermediate group of properties do not depend on any properties other than those declared in itself, those declared in the first group of properties, and those declared in intermediate groups of properties between itself and said first group of properties**, since complex-types.xsd is equivalent to the claimed second schema.

Vlist teaches that the main schema includes simple-types.xsd and complex-types.xsd (p 2, third paragraph block), which meet the limitation of **generating at least one schema with properties that depend on some or all of the properties in said**

**first group of properties and said at least one intermediate group of properties,** since main.xsd inherits the properties of the two included schemas – schema inclusion is a logical inclusion (p 1, first block under 8.1).

11. Regarding dependent claim 14, Vlist teaches that redefinitions are implemented using the xs:redefine element with a schemaLocation attribute (like xs:include). Its children are component definitions that replace the definition found in the included schema. The definitions that are not included in the xs:redefine element are kept unchanged (p 3, first block), which meet the limitation of **inserting additional properties into one or more of the first group of properties, the at least one intermediate group of properties, and at least one schema that results from said generating.**

Vlist teaches that W3C XML Schema contains a feature that allows derivation of global types and group definitions during an inclusion; it keeps the same name after the derivation. Thus, the semantic of these redefinitions is "take this definition instead of the one you've found in the included schema, but make sure that it's a valid derivation so that applications are not too surprised about the change." (p 3, third block paragraph), which meet the limitation of **determining if said additional properties are common to more than one of the at least one schema that results from said generating at least one schema.**

Vlist teaches that are implemented using the xs:redefine element with a schemaLocation attribute (like xs:include). Its children are component definitions that

replace the definition found in the included schema. The definitions that are not included in the xs:redefine element are kept unchanged, which means that a xs:redefine with no child element is strictly equivalent to xs:include (p 3, first block), which meet the limitation of **inserting any additional properties that are common into one or more of said first group of properties and said at least one intermediate group of properties; and inserting any additional properties that are not common into the at least one schema that results from said generating at least one schema.**

Regarding dependent claim 15, Vlist teaches that the simple-type schema (simple-type.xsd) defines strings – string255 and string32 (p 1, bottom, simple-type.xsd code), which meet the limitation of **at least one property in the first group of properties declares a basic text type for identifying text.**

Regarding dependent claim 16, Vlist teaches that the simple-type schema (simple-type.xsd) defines bookID to have a specific format (pattern value) and will truncate any extra data and replace it with just that data that fits the format or pattern specified (p 1, bottom, simple-type.xsd code), which meet the limitation of **at least one property in the first group of properties declares an attribute for identifying data that will be replaced and corresponding data that the identified data will be replaced with.**

Regarding dependent claim 17, Vlist teaches that the simple-type schema (simple-type.xsd) defines bookID to have a specific format (pattern value) and will truncate any extra data and replace it with just that data that fits the format or pattern specified (p 1, bottom, simple-type.xsd code), which meet the limitation of **at least one property in the first group of properties declares an attribute for marking data proximal to the identified data that will also be replaced with the corresponding data.**

Regarding dependent claim 18, Vlist teaches that the simple-type schema (simple-type.xsd) defines strings – string255 and string32 (p 1, bottom, simple-type.xsd code), which meet the limitation of **at least one property in the first group of properties declares an attribute for identifying data that can be referenced in multiple locations of a document instance, thereby supporting easy updating of the data.**

Regarding dependent claim 19, Vlist teaches that the simple-type schema (simple-type.xsd) defines a date element for identifying dates (p 1, bottom, simple-type.xsd code), which meet the limitation of **at least one property in the first group of properties or in the at least one intermediate group of properties declares one or more of an acronym element for identifying acronyms, an abbreviation element for identifying abbreviations, a quotation element for identifying quotations, a date element for identifying dates, a foreign phrase element for identifying foreign**



**phrases, a conditional element for marking data to be conditionally included, a subscript element for identifying subscripts, and a superscript element for identifying superscripts.**

Regarding dependent claim 20, Vlist teaches that the complex-type schema (complex-type.xsd) defines a title for identifying the title of a book (p 2, middle, complex-type.xsd code), which meet the limitation of **at least one property in the first group of properties or in the at least one intermediate group of properties declares one or more of a paragraph element for identifying paragraphs and a title element for identifying titles.**

Regarding dependent claim 21, Vlist teaches that we now have an included schema (complex-types.xsd), which references elements (such as author, character, or dead), that are defined in the main schema using datatypes defined in either simple-types.xsd or complex-types.xsd (p 2, last block), which meet the limitation of **one or more of the at least one first schema and the at least one second schema comprises a plurality of schemas, and wherein at least one schema in said plurality of schemas refers some or all of the other schemas in said plurality of schemas.**

Regarding dependent claim 22, Vlist teaches that the main schema defines information relating to a book (p 10, bottom), which meet the limitation of **at least one**

**schema that results from said generating defines a complete document structure for one or more of a glossary, a frequently asked questions document, and a reference document.**

12. Regarding claims 1 – 12 and 23 – 30, the claims and are rejected along the same rationale as claims 13 – 22.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NH



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